

**REMARKS**

Claims 13, 16 and 18-24 are pending in this application. By this Amendment, claims 13 and 24 are amended. Support for the amendments to claims 13 and 24 can be found in the specification at least at paragraph [0011], and Figures 5, 12 and 13 and the corresponding description. Thus, no new matter is added.

The courtesies extended to Applicants' representative by Examiners Airapetian and Zurita at the personal interview held December 8, 2006, and the telephone interview held December 22, 2006, are appreciated. The remarks below include Applicants' record of the interview.

**I. The Claims Define Patentable Subject Matter**

The Office Action claims 13, 16, 19 and 20-22 under 35 U.S.C. §103(a) over U.S. Patent No. 5,748,484 to Cannon et al. in view of U.S. Patent No. 6,259,405 to Stewart; rejects claim 18 under 35 U.S.C. §103(a) over Cannon and Stewart, and further in view of U.S. Patent Application Publication No. 2003/0208442 to Cockrill et al.; rejects claim 23 under 35 U.S.C. §103(a) over Cannon and Stewart, and further in view of U.S. Patent No. 6,174,579 to Slyster et al.; and rejects claim 24 under 35 U.S.C. §103(a) over Cannon and Stewart, and further in view of Slyster. These rejections are respectfully traversed.

None of the applied references, alone or in a permissible combination, teaches or suggests each and every feature recited in the rejected claims. For example, neither Cannon nor Stewart teaches or suggests "preparing electronic personalized product producing data on a portable hand-held device based on instructions provided to a customer prior to preparing the electronic personalized product producing data, the preparing including displaying the instructions to the customer on the portable hand-held device, and entering and accepting the information on the portable hand-held device by the customer to prepare the electronic personalized product producing data; sending the personalized product producing data from

the portable handheld device by wireless communication to a producing facility...; receiving, by wireless communication, electronic personalized product producing data in a first format..., electrically sequentially storing sets of the personalized product producing data..., "as recited in independent claim 13, and as similarly recited in independent claim 24 (emphasis added).

Cannon does not disclose preparing and transmitting electronic personalized product producing data on a portable hand held device in a first format. Cannon merely discloses that an order can be transmitted via facsimile or an input means connected to a computing means. For example, the order form of Cannon may be filled out using a keyboard, such as at a personal computer, or using a input means, i.e. a television remote, and television information system where the customer can view the desired images and greeting card options and respond to selected prompts (Cannon at col. 16, line 57 - col. 17, line 1). That is, the card display image files of Cannon are transmitted from a control computer 63 at the cable TV control center 60 over conventional cable TV line to the CATV card display/order system 67, where the card display image files are displayed on the television set 55 via a cable channel. An order form of Cannon can be displayed on a television set 55 and the consumer then enters order information using an input means. The order information of Cannon can then be transmitted through a modem 41 to the control computer 63 and from the control computer 63 at the cable TV control center 60 to a card printing system site 54 over telecommunication lines 52 (Cannon at col. 15, line 57- col. 16, line 39). Thus, the input means of Cannon is not a portable hand held device that sends the personalized product producing data to the producing facility by wireless communication, wherein the instructions are displayed to the customer on the portable hand-held device, and the information is entered and accepted by the customer to prepare the electronic personalized product producing data, as in the claimed invention.

However, during the telephone interview, Examiner Airapetian argued that it would have been obvious to make the input means of Cannon (television remote) portable in view of *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952). *In re Lindberg* merely held the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. This assertion is respectfully traversed.

The alleged wireless controller, i.e., tv remote of Cannon, is already portable. Further, there are differences between the claimed hand-held device and the tv remote of Cannon, not just the alleged portability. For example, the information of Cannon is not prepared on the portable hand-held device nor is the information sent by wireless communication in a first format to a producing facility. The input means of Cannon merely selects information displayed on the television set. The information necessary to complete an order may be requested from the consumer by the control computer 63 or by the computer contained in the smart CATV converter 58, which is then displayed on the television set. The information is then transmitted from the CATV card display/order system 67, i.e., smart CATV converter 58, to the control computer 63 at the cable TV control center 60 (Cannon at col. 16, lines 4-9). In other words, the information is not prepared on the input means of Cannon. The information can be prepared by the control computer 63 or by the computer contained in the smart CATV converter 58 of Cannon. Thus, Cannon does not disclose a portable hand-held device displays the instructions to the customer, and enters and accepts the information is entered and accepted by the customer to prepare the electronic personalized product producing data.

Further, as discussed above, the information of Cannon is transmitted through a modem 41 to the control computer 63 and from the control computer 63 at the cable TV control center 60 to a card printing system site 54 over telecommunication lines 52 (Cannon

at col. 16, lines 31-39). The information of Cannon is thus not sent from the portable handheld device by wireless communication to a producing facility as in the claimed invention. Accordingly, Cannon does not disclose the preparation and transmission of electronic personalized product producing data on a portable hand-held device in a first format, as recited in the independent claims.

Moreover, the system of Cannon does not electrically analyze each piece of electronic personalized product producing data in the first format, convert the data to a piece of electronic data in a second format, receive the piece of data in the second format and record the piece of data in the second format on an output medium to produce a personalized product, as recited in independent claim 13, and as similarly recited in independent claim 24.

The Office Action asserts that Cannon discloses receiving electronic personalized product producing data in a first format at col. 18, line 15, i.e., ASCII format. The Office Action further asserts that Cannon discloses analyzing this information in a first format and converting it to a piece of electronic data in a second format at col. 17, lines 48-51, i.e., receiving orders in a standard facsimile transmission format. However, the alleged first format and the second format both correspond to two different data formats of Cannon received by the card printing facility.

The ASCII format of Cannon, the alleged first format, corresponds to order information that is transmitted from a computing means through a modem over telecommunication lines (Cannon at col. 17, lines 4-11). The alleged conversion to a piece of electronic data of Cannon relates to facsimile orders. For example, Cannon discloses receiving orders in a standard facsimile transmission format and converting them into PCX image format files. The PCX image is stored in an order image file (Cannon at col. 17, lines 48-51). Thus, Cannon merely discloses receiving two different formats of data.

Further, Cannon does not disclose analyzing data in a first format that is stored and converting this data into a second format for recording on an output medium. As discussed above, Cannon merely discloses receiving data, i.e., order information, either via fax or modem, and storing this data in an order information database 70 (Cannon at col. 18, lines 9-22). Cannon uses another program based on the card orders from the order information database 70 to print the cards. Thus, Cannon does not "convert" the first format into a second format for recording on an output medium, as recited in independent claims 13 and 24.

Stewart does not remedy the deficiencies of Cannon. The Office Action cites Stewart for only its alleged teaching of "producing of said product at specified location in order to receive the product, and automatically notifying a customer of at least one said receipt...wherein the automated method incorporates the requires and producing of the personalized product taking place within a limited, defined geographic area or facility..." as recited in independent claim 13, and as similarly recited in independent claim 24. Nowhere does Stewart teach or suggest converting the first format into a second format for recording on an output medium. Thus, the claimed invention would not have been achieved by the alleged modification of Cannon with the teachings of Stewart.

One of ordinary skill in the art would not have been motivated to combine the system of Cannon with the alleged teachings of Stewart. As argued above, Cannon does not disclose a portable hand-held device. Cannon only discloses the use of an input means, i.e., a tv remote (Cannon at col. 16, lines 16-28). The input of Cannon must be in the vicinity of the television to be able to transmit the information to the tv, and the information is transmitted from the computer through telephone lines. Stewart discloses a geographic based communications service system that uses a portable computing device (PCD) to connect to the network and access information or services from the network, i.e., printing services (Stewart at Abstract). Stewart automatically determines the geographic location of the mobile

user (MU) through a wireless access point (AP) (Stewart at col. 19, lines 46-col. 20, line 4).

Because the system of Cannon does not disclose a wireless network, i.e., the capability of utilizing a wireless access point to determine the geographic location, the system of Cannon could not support the alleged teachings of Stewart. Thus, one of ordinary skill in the art would not have been motivated to combine the system of Cannon with the alleged teachings of Stewart.

Further, Cockrill and Slyster do not remedy the deficiencies of Cannon and Stewart. The Office Action cites Cockrill and Slyster for only their alleged teachings of authenticating each of the customers based on customer information and printing personalized labels/stickers, respectively.


Thus, for at least these reasons, independent claims 13 and 24 are patentable over the applied references. Further, claims 16 and 18-23, which variously depend from independent claim 13, are also patentable over the applied references, for at least the reasons discussed above, as well as for the additional features they recite. Withdrawal of the rejections is respectfully requested.

## **II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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